



Atty. Dkt. No. 085449-0158

1/2W Dte

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Karin Butz et al.
Title: Peptides for Inducing Apoptosis
in Tumor Cells
Appl. No.: 10/519,539
International Filing Date: 7/1/2003
371(c) Date: 3/15/05
Patent No.: 7,544,768
Grant Date: 6/9/2009
Examiner: Laura B. Goddard
Art Unit: 1642
Confirmation Number: 3633

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent, which issued on 6/9/2009 as U.S. Patent No. 7,544,768.

The Patent Office determined that the patent was entitled to 80 days of PTA. Applicants believe that this PTA determination was made in accordance with the "Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)" published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of "overlap" are limited to "periods of time . . . [that] occur on the same day." *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." *Id.*

Applicants have recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and have determined that the patent is entitled to **84** days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B):	260 days
(b) Total Applicant delay:	176 days
Final PTA Determination:	84 days

Applicants therefore respectfully request that the patent be accorded **84** days PTA.

The patent is not subject to a terminal disclaimer.

Payment of the requisite fee is submitted herewith. Should no proper payment be enclosed herewith, as by the credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Applicants request further that a decision on this request be deferred or delayed until a final decision has been rendered in *Wyeth v. Dudas*, which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120.

Respectfully submitted,

Date: August 7, 2009

By  _____

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Docket Number: 085449-0158
 Application Number: 10/519539
 Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Application Filing Date	03/15/2005	0		
	14 month From Application date	05/15/2006	426		
Edit Delete	Restriction Requirement	05/19/2006	430	4	
Edit Delete	Restriction Requirement Response Received at PTO	06/20/2006	462		
Edit Delete	Non-Final Office Action	09/08/2006	542		
	Non-Final Office Action + 3 months	12/08/2006	633		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	03/05/2007	720		87
Edit Delete	Non-Final Office Action	06/25/2007	832		
	Non-Final Office Action + 3 months	09/25/2007	924		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	10/25/2007	954		30
Edit Delete	Final Office Action	01/29/2008	1,050		
	3 Year Period Starts	03/15/2008	1,096		
	Final Office Action + 3 months	04/29/2008	1,141		
Edit Delete	Notice of Appeal Received at PTO	06/27/2008	1,200		59
Edit Delete	Advisory Action	10/02/2008	1,297		
Edit Delete	Request For Continued Examination (including amendment)	11/26/2008	1,352	256	
	3 Year Period Stopped	11/26/2008	1,352		
Edit Delete	Notice of Allowance	02/05/2009	1,423		
Edit Delete	Issue Fee Paid	04/30/2009	1,507		
Edit Delete	Patent Grant Date	06/09/2009	1,547		
			Totals:	260	176
			PTA:		84

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IP: 10.14.52.39

Foley & Lardner LLP

8/7/2009